

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371		ATTORNEY'S DOCKET NUMBER 529282001700
INTERNATIONAL APPLICATION NO. PCT/AU2003/001661		U.S. APPLICATION NO. (if known, see 37 CFR 1.5) 10/538,499
INTERNATIONAL FILING DATE 11 December 2003		PRIORITY DATE CLAIMED 11 December 2002
TITLE OF INVENTION PYRAZINE-BASED TUBULIN INHIBITORS		
APPLICANT(S) FOR DO/EO/US Christopher John BURNS et al.		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
1. <input type="checkbox"/> This is a FIRST submission of items concerning a submission under 35 U.S.C. 371. 2. <input checked="" type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a submission under 35 U.S.C. 371. 3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below. 4. <input type="checkbox"/> The US has been elected (Article 31). 5. <input type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371 (c)(2)) a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau). b. <input type="checkbox"/> has been communicated by the International Bureau. c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US). 6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)). a. <input type="checkbox"/> is attached hereto. b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4). 7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau). b. <input type="checkbox"/> have been communicated by the International Bureau. c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired. d. <input type="checkbox"/> have not been made and will not be made. 8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)). 9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). 10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)). Items 11 to 20 below concern document(s) or information included: 11. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98. 12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included. 13. <input type="checkbox"/> A preliminary amendment. 14. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76. 15. <input type="checkbox"/> A substitute specification. 16. <input type="checkbox"/> A power of attorney and/or change of address letter. 17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 – 1.825. 18. <input type="checkbox"/> A second copy of the published International Application under 35 U.S.C. 154(d)(4). 19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).		

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

U.S. APPLICATION NO. (if known, see 37 CFR 1.5) 10/538,499		INTERNATIONAL APPLICATION NO. PCT/AU2003/001661		ATTORNEY'S DOCKET NUMBER 529282001700	
20. <input checked="" type="checkbox"/> Other items or information: Response to Notification re Inventorship (2 pages) Copy of Notification (3 pages) Copies of Form PCT/IB/306 Notifications filed 09/08/2004 (3 pages) Return Receipt Postcard					
The following fees have been submitted				CALCULATIONS	PTO USE ONLY
21. <input type="checkbox"/> Basic national fee (37 CFR 1.492(a)) \$300				\$	
22. <input type="checkbox"/> Examination fee (37 CFR 1.492(c)) If the written opinion prepared by ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4) \$0 All other situations \$200				\$	
23. <input type="checkbox"/> Search fee (37 CFR 1.492(b)) If the written opinion of the ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4) \$0 Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority \$100 International Search Report prepared by an ISA other than the US and provided to the Office or previously communicated to the US by the IB \$400 All other situations \$500				\$	
TOTAL OF 21, 22 and 23 =				\$ 0.00	
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing in compliance with 37 CFR 1.821(c) or (e) or computer program listing in an electronic medium) (37 CFR 1.492(j)). The fee is \$250 for each additional 50 sheets of paper or fraction thereof.					
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	RATE		
- 100 =	/50 =		x \$250.00	\$	
Surcharge of \$130 for furnishing any of the search fee, examination fee, or the oath or declaration after the date of commencement of the national stage (37 CFR 1.492(h)).				\$	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	16 - 40 =		x	0.00	
Independent claims	1 - 6 =		x	0.00	
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+		
TOTAL OF ABOVE CALCULATIONS =				\$ 0.00	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.				0.00	
SUBTOTAL =				\$ 0.00	
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(i)).				\$	
TOTAL NATIONAL FEE =				\$ 0.00	
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property				\$	
				\$	
TOTAL FEES ENCLOSED =				\$ 0.00	
				Amount to be refunded:	\$
				Amount to be charged	\$

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

- a. ☐ A check in the amount of \$ _____ to cover the above fees is enclosed.
- b. ☐ Please charge my Deposit Account No. _____ in the amount of \$ 0.00 to cover the above fees.
A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 03-1952. A duplicate copy of this sheet is enclosed.
- d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. **Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038

NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

SEND ALL CORRESPONDENCE TO:

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REGISTRATION NUMBER

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)
10/538,499

INTERNATIONAL APPLICATION NO.
PCT/AU2003/001661

ATTORNEY'S DOCKET NUMBER
529282001700

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 915683570 US, in an envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 24, 2006

Signature: Marian Christopher

Marian Christopher

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 915683570 US, in an envelope addressed to: MS PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 24, 2006

Signature: 

Marian Christopher

Docket No.: 529282001700
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Christopher John BURNS et al.

Application No.: 10/538,499

Filed: Intl. December 11, 2003

For: PYRAZINE-BASED TUBULIN INHIBITORS

Confirmation No.: Not Yet Assigned

Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

RESPONSE TO NOTIFICATION DATED 11 OCTOBER 2006

MS PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Notification mailed 11 October 2006, wherein Applicants were advised of defects in the Declaration filed on 3 August 2006, in that the inventorship did not conform with the international application. The Declaration filed on 3 August 2006 contained the signatures of five inventors, while the international application listed two inventors. The Notification provided a one month time period for response. That time period expires on 11 November 2006.

Accompanying this response are the following:

1. A copy of the Notification dated 11 October 2006 (2 pages)
2. Copies of three Form PCT/IB/306 recording the addition of Inventors Xianyong BU, Harrison SIKANYIKA, and Michael Francis HARTE, which were recorded in the

International Bureau of WIPO and forwarded to the designated Offices concerned on 8 September 2004.

Applicants request that the three Form PCT/IB/306 be made a part of the record in this application and that the Declaration filed on 3 August 2006 be accepted.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 529282001700.

Dated: October 24, 2006

Respectfully submitted,

By Kate H. Murashige
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JULIEU. Missing Reg. Fee
REMINDER: 10-25-06
FINAL DUE DATE: 11-11-06

COPY

In re Application of
BURNS et al.
Application No.: 10/538,499
PCT No.: PCT/AU2003/001661
Int. Filing Date: 11 December 2003
Priority Date: 11 December 2002
Attorney Docket No.: 529282001700
For: PYRAZINE-BASED TUBULIN
INHIBITORS

NOTIFICATION

This application is before the Office of PCT Legal Administration for consideration of matter arising under 35 U.S.C. 371.

BACKGROUND

On 11 December 2003, applicant filed international application PCT/AU2003/001661, which designated the United States and claimed a priority date of 11 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 June 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 June 2005 (11 June 2005 being a Saturday).

On 09 June 2005, applicants filed a transmittal letter for entry in to the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 10 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required.

On 03 August 2006, applicants filed a submission including a declaration of inventors and the surcharge under 37 CFR 1.492(h).

DISCUSSION

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declaration filed 03 August 2006 does not list the inventorship set forth in the international application. The declaration lists five inventors while the international application lists two inventors. However, a Form PCT/IB/306 does not appear in the file for any of the additional three inventors. Nor is there any other indication that a PCT Rule 92^{bis} change has been made in the above-identified international application. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application and the declaration filed 03 August 2006 is not sufficient.

CONCLUSION

Applicants are required to file a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) within a time limit of ONE MONTH from the date of this decision or within the time remaining in the response set forth in the NOTIFICATION mailed 10 February 2006, whichever is longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the NOTIFICATION mailed 10 February 2006 may be extended under 37 CFR 1.136(a).

The declaration must name the inventive entity named in the international application, or a proper change of inventorship under 37 CFR 1.497(d) must be filed, or Forms PCT/IB/306 indicating changes effected under PCT Rule 92^{bis} corresponding to the declaration filed 03 August 2006 must be filed.

Failure to timely file a proper reply will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty

Application No.: 10/538,499

-3-

Legal Administration

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